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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/600,967	06/20/2003	Hiroataka Hara	00650-0741	6569

32116 7590 03/03/2006

WOOD, PHILLIPS, KATZ, CLARK & MORTIMER
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CHICAGO, IL 60661

EXAMINER

YAO, SAMCHUAN CUA

ART UNIT PAPER NUMBER

1733

DATE MAILED: 03/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action Before the Filing of an Appeal Brief	Application No. 10/600,967	Applicant(s) HARA ET AL.	
	Examiner Sam Chuan C. Yao	Art Unit 1733	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 13 February 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
 b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The reply was filed after the date of filing a Notice of Appeal, but prior to the date of filing an appeal brief. The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
 (a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
 (b) ☐ They raise the issue of new matter (see NOTE below);
 (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

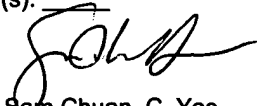
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
 5. ☐ Applicant's reply has overcome the following rejection(s): _____.
 6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
 7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
 The status of the claim(s) is (or will be) as follows:
 Claim(s) allowed: 10-13 and 15.
 Claim(s) objected to: _____.
 Claim(s) rejected: 1-9, 14, 16-17 and 25.
 Claim(s) withdrawn from consideration: 18-24, 26 and 27.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
 9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
 10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: see the attached examiner's remarks.
 12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s).
 13. ☐ Other: _____.


 Sam Chuan C. Yao
 Primary Examiner
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Continuation of 2. NOTE: adding "without the second belt ... on the second mold assenbly" to claim 9 raises new issue which would require further search and/or consideration .

Remarks

I. The IDS filed on 02-13-06 was NOT considered because it fails to comply CFR 1.97 (d).

While the IDS complies with condition 2 of this section, it does not meet condition 1 of this section, since it fails to include a statement specified in paragraph (e) of this section.

A quotation of CFR 1.97 (e) is provided herein for Counsel's convenience.

A statement under this section must state either:

(1) That each item of information contained in the information disclosure statement was first cited in any communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of the information disclosure statement; or

(2) That no item of information contained in the information disclosure statement was cited in a communication from a foreign patent office in a counterpart foreign application, and, to the knowledge of the person signing the certification after making reasonable inquiry, no item of information contained in the information disclosure statement was known to any individual designated in § 1.56(c) more than three months prior to the filing of the information disclosure statement.

II. On pages 11-13, Counsel argued that "... the withdrawal of claims 26 and 27 from consideration is improper ...". Accordingly, both claims 1 and 26 require "... the steps of separately forming the first and 2nd belt/belt sleeve components, ..., and applying a

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radial force to the first belt ... without the presence of the second belt/belt sleeve component. In each claim, after the plurality of ribs and/or cog teeth are formed in the first belt/belt sleeve component, the first and second sleeve components are joined to each other.”. While claims 1 and 26 substantially require the above process steps, this does not change the fact that, a critical limitation in independent claim 1 find no counterpart limitation in independent claim 26, and vice versa. For instance, claim 1 requires forming a 1st sleeve component and a 2nd sleeve component **into continuous shape** and joining 1st and 2nd sleeve components after these two components have been formed, where the 1st and 2nd components “*residing one **within the other***” (bold-face added); but does not require “*forming a second ... sleeve component ... against a second mold assembly; and after forming ... first ... sleeve component; joining the first and second belt/belt sleeve components ... thereafter radially urging one of the first and second ... components to against the other ...*” as recited in claim 26 of a newly added group; and, vice versa. **The differences between these groups are critical and significant to the extent that the inventions constitute prima facie patentably distinct combinations**, absent evidence to the contrary. In any event, Counsel’s argument is moot, because once the claims in the elected group is found to be allowable, Examiner is **willing to rejoin withdrawn claims 26-27** as long as ALL limitation in the **broadest allowable independent claim** in the elected group is incorporated into independent claim 26.

III. On page 12 full paragraph 1, Counsel argued that “[a]ccording to the invention, by *separately forming the first and second belt/belt sleeve components, ... using a large*

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pressure. Since the pressure is applied to form the ribs and/or cog teeth without being applied to the second belt/belt sleeve component, the load carrying member and part of the cushion rubber layer need not be subjected to this same high pressure, as might cause the detrimental displacement and elongation, ...”. (emphasis added) It is respectfully submitted that, Counsel's argument is not commensurate with the scope of claim 1 as presently recited. This claim as presently recited does not positively require applying high pressure to form a second belt/belt sleeve. As noted in the prior office action, the recited limitation failed to define over a process where components are conventionally built-up serially on a molding drum, because claim 1 as present recited does not require positively applying any radial force to a 2nd sleeve component against a molding surface during the 2nd sleeve component forming step nor does this claim define positively the configuration of a 2nd sleeve component after being formed. In other words, this limitation fails to distinguish over the building up of a cushion rubber and a load carrying cord onto a molding drum surface to form a 2nd sleeve component and then placing a preformed ribbed compression rubber layer (i.e. a 1st sleeve component) onto the 2nd sleeve component.

It is strongly suggested for Applicant to amend the 2nd belt forming step in claim 1 to further require separately and radially pressing the layers (i.e. rubber layer and load carrying member) in the 2nd belt against a second mold assembly.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sam Chuan C. Yao whose telephone number is (571)

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272-1224. The examiner can normally be reached on Monday-Friday with second Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Richard Crispino can be reached on (571) 272-1171. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Sam Chuan C. Yao
Primary Examiner
Art Unit 1733

Scy
03-01-06